

Application No. 10/635,065
Amendment dated: April 10, 2006
Reply to Office Action of January 9, 2006

121689-1

REMARKS/ARGUMENTS

In the Office Action dated January 9, 2006, the Examiner rejected claims 1 – 8, and objected to claim 5. Claims 9 – 22 were previously withdrawn. In this response, claim 5 has been amended to correct a typographical error. No new matter has been added.

Claim Objections

The Examiner objected to claim 5 because the claim did not end with a period. The Applicant thanks the Examiner for pointing out this unintended oversight. Claim 5 has been amended to include the period at the end of the sentence. No new matter has been added.

Claim Rejections under 35 USC 103 (a)

(I) The Examiner rejected claims 1 – 2 and 6 – 8 under 35 USC 103(a) as being unpatentable over Bramhall (US Pat. 4,323,533) in view of Mittman (US Pat. 3,176,058). The Applicant courteously traverses these rejections.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP Section 2143 - Section 2143.03

Application No. 10/635,065
Amendment dated: April 10, 2006
Reply to Office Action of January 9, 2006

121689-1

The Examiner has failed to establish a prima facie case of obviousness. For example, in the present instance, in order to establish prima facie obviousness, all the claim limitations must be taught or suggested by the combination of the Bramhall and the Mittman references. It is the Applicant's position that no combination of the Bramhall and Mittman references can be read to disclose or suggest the instant invention. This can be demonstrated by reviewing the elements (limitations) of claim 1 of the instant application, the only independent claim currently under examination.

Claim 1 recites a process for embossing a film, wherein the process comprises four distinct elements (limitations) (a), (b), (c), and (d):

(a) heating a resin and forming a flowable melt; (b) directing a planar film of the flowable melt to a first nip; (c) embossing a first side of the flowable melt and cooling a second side of the flowable melt to form an embossed film; and (d) cooling the embossed film.

The Examiner asserts that Bramhall teaches each of elements (a), (b) and (d) of Applicant's claim 1, but acknowledges that Bramhall does not disclose element (c), "embossing a first side of the flowable melt and cooling a second side of the flowable melt to form an embossed film". The Examiner invokes the Mittman reference to provide the missing element.

A review of the Mittman reference indicates that element (c) of the Applicant's claim 1, "embossing a first side of the flowable melt and cooling a second side of the flowable melt to form an embossed film", is neither disclosed nor suggested by the Mittman reference. For Example item 12 shown in Figures 1 and 2 of Mittman is described as a "film" not a "flowable melt". Mittman at column 2, lines 22-38 describes the embossing of a film or a sheet, not a "flowable melt". Mittman at column 4, lines 20-34 describes the process implicit in Figure 1 as operating on a "film" 12. At column 4 lines 60-74 Mittman describes the embossing of an "unsupported film" referred to as

Application No. 10/635,065
Amendment dated: April 10, 2006
Reply to Office Action of January 9, 2006

121689-1

item 12. Finally, Mittman's claims are directed to "embossing a sheet of relatively soft plastic...." At no point does the Mittman reference disclose or suggest a process for embossing a "flowable melt" from which an embossed film is ultimately formed.

Those skilled in the art will appreciate the difference between an embossing process which operates upon an unsupported plastic film or sheet (as in Mittman) and the embossing process of the instant invention which forms a flowable melt and embosses a first side of the flowable melt and cooling a second side of the flowable melt to form an embossed film.

The following example is illustrative. A flowable melt may be formed from a plastic material initially in powder form by subjecting the plastic material in powder form to extrusion to provide a flowable melt which may be converted directly from the melt into an embossed film using the process of the instant invention. The process disclosed by Mittman would first require the preparation of a film or sheet from the plastic material initially in powder form, and thereafter embossing the film or sheet in a separate step.

Because Mittman neither discloses nor suggests the embossing of a flowable melt, Mittman cannot furnish the claim element acknowledged by the Examiner to be absent from the Bramhall reference: (c) embossing a first side of the flowable melt and cooling a second side of the flowable melt to form an embossed film. The Examiner thus fails to establish a prima facie case of obviousness, and thus the rejection of any of the claims of the instant invention under 35 U.S.C. 103(a) as being unpatentable over Bramhall in view of Mittman is unwarranted. The Applicant urges that claim 1 and claims dependent thereupon recite subject matter patentable over the cited references.


In view of the above, the Applicant requests that the Examiner kindly consider the Applicant's arguments and reasoning contained herein, and if moved by such to withdraw his initial rejection of claims 1-8. Upon favorable consideration by the Examiner a prompt allowance of claims 1-8 is courteously solicited. Should the need arise, the

Application No. 10/635,065
Amendment dated: April 10, 2006
Reply to Office Action of January 9, 2006

121689-1

Examiner is respectfully requested to contact the Applicant's representative at the telephone number listed below.

Respectfully submitted,


Andrew J. Caruso
Reg. No. 48, 520

General Electric Company
Building K1, Room 3A71
Niskayuna, New York 12309
April 10, 2006
Telephone: (518) 387-7354